

REMARKS

In the Office Action dated July 12, 2004, the Examiner rejected claim 28 under the judicially created doctrine of obviousness-type double patenting; rejected claims 28-36 under 35 U.S.C. § 112, first paragraph; rejected claims 28-33, 37-41, 43-51, and 55-59 under 35 U.S.C. § 102(b) as being anticipated by Wollrath et al. ("Java-Centric Distributed Computing"); rejected claims 28, 37, 44-46, and 55 under 35 U.S.C. § 102(b) as being anticipated by Dave et al. ("Proxies, Application Interfaces, and Distributed Systems"); and rejected claims 34-36, 42, 52-54, 60, and 61 in view of Wollrath et al. in view of Allard et al. (U.S. Patent no. 6,018,619).

By this amendment, Applicants have added new claims 62-88. Based on the following remarks, Applicants respectfully traverse the rejections of claims 28-61.

I. The Obviousness-Type double Patenting Rejection of Claim 28

The Examiner provisionally rejects claim 28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 43 of U.S. Patent Application No. 10/408,365. Applicants traverse this rejection for the following reason.

U.S. Patent Application No. 10/408,365 was filed on April 8, 2003. Our records indicate that on April 8, 2003, a preliminary amendment was filed that cancelled, among other claims, claim 43. The amendment indicates that claims 51, 52, 54-59, 64-73, and 75-79 remain pending for Application No. 10/408,365.

Accordingly, the obviousness-type double patenting rejection of claim 28 in view of claim 43 of Application No. 10/408,365 is improper because that claim is no longer pending in the application. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claim 28 and allow the claim.

II. The Rejection of Claims 28-36 under 35 U.S.C. § 112, First Paragraph

The Examiner rejects claims 28-36 as failing to comply with the enablement requirement of 35 U.S.C. § 112, First Paragraph. In particular, the Examiner asserts that the phrase “executable code” recited in claim 28 is not supported by the specification. See *Office Action*, page 3, lines 1-9. Applicants respectfully disagree with the Examiner.

Applicants’ specification is enabling for claim 28. A review of the specification shows that various aspects of Applicants’ invention associated with the lookup service and the dynamic loading of executable code to facilitate access to a network service are disclosed. For example, page 32, lines 16-19 state that “[u]nlike previous lookup services, the lookup service consistent with the present invention returns the code needed to access the service directly. Using the dynamic loading of stub information in this way allows the client to receive all the code necessary to facilitate use of the service on a remote server.” Further, page 32, lines 4-6 states that “[a]fter it is loaded, the service 38 can be remotely invoked. The use of the stub information to invoke remote processing of the service 38 is performed in the same manner as previously discussed in connection with FIG. 3.”

Accordingly, contrary to the Examiner's assertions, Applicants' specification is enabling for "executable code." Therefore, Applicants request that the rejection of claims 28-36 under 35 U.S.C. § 112, first paragraph be withdrawn and the claims allowed.

III. The Rejection of Claims 28-33, 37-41, 43-51, and 55-59 under 35 U.S.C. § 102(b)

The Examiner rejects claims 28-33, 37-41, 43, 51, and 55-59 under 35 U.S.C. § 102(b) as being anticipated by Wollrath et al. Applicants submit that Wollrath et al. is not eligible as prior art under Section 102(b) because Applicants' application has an effective filing date of March 20, 1998, which is less than one year from the publication date of the reference, i.e., May/June 1997. Accordingly, the rejection of these claims in view of Wollrath et al. should be presented under 35 U.S.C. § 102(a), which precludes a person from obtaining a patent for an invention if it "was known or used by other in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent."

Applicants disagree with the Examiner's contentions that the reference discloses the recitations of claims 28-33, 37-41, 43, 51, and 55-59. To advance prosecution, however, Applicants provide herewith declarations pursuant to 37 C.F.R. § 1.132 by Jim Waldo and Ann Wollrath (co-authors of Wollrath et al. and co-inventors of the above-identified application). Each of them declare he/she is an inventor of the subject matter found in Wollrath et al. used to reject claims 28-33, 37-41, 43, 51, and 55-59.

According to M.P.E.P. § 715.01, Applicants may "overcome prior art rejections relying on references or activities which are available as prior art under

35 U.S.C. 102(a) ... by providing that the subject matter relied upon in the reference ... was applicant's own invention." As explained, the rejection of claims 28-33, 37-41, 43, 51, and 55-59 under 35 U.S.C. § 102(b) as being anticipated by Wollrath et al. is improper and should be under 35 U.S.C. § 102(a).

Because the declarations under 37 C.F.R. § 1.132 by Ann Wollrath and Jim Waldo eliminate Wollrath et al. as an available reference under 35 U.S.C. § 102, Applicants request that the rejection of claims 28-33, 37-41, 43, 51, and 55-59 in light of Wollrath et al. be withdrawn and the claims allowed.

IV. The Rejection of Claims 28, 37, 44-46, and 55 under 35 U.S.C. § 102(b)

In order to properly anticipate Appellants' claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

In rejecting claims 28, 27, 44-46, and 55 under 35 U.S.C. § 102(b), the Examiner asserts that Dave et al. teaches "receiving a request from a client by the lookup service for access to one of the network services, the client being remote with respect to the lookup service [5.1 RPC Implementations]; and returning a resource locator to the client from the lookup service so that the client may dynamically load executable code to

facilitate access of the one network service [5.1 RPC Implementations].” See *Office Action, page 5, lines 1-5.* Applicants respectfully disagree with the Examiner’s interpretation of Dave et al.

Dave et al. discloses conventional RPC mechanisms that use stubs to implement non-local calls. In particular, Dave et al. mentions in Section 5.1 that the “functions performed by the stub are determined at compile time and, once linked to an application, the application becomes bound to these functions.” See Dave et al., Section 5.1, ¶ 1. Although Dave et al. discusses in Sections 5.2 and 5.3 the use of tables that store information about marshalling routines for parameters in remote methods and define interfaces for various servers, the reference does not disclose receiving a request from a client by a lookup service for access to a network service and returning a resource locator to the client from the lookup service so that the client may dynamically load executable code to facilitate access of the one network service, as asserted by the Examiner.

Because Dave et al. does not support the rejection of claims 28, 27, 44-46, and 55, and the Examiner’s positions in support of this rejection are improper, Applicants respectfully request that the rejection of this claim under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

V. The Rejection of Claims 34-36, 42, 52-54, 60, and 61 under 35 U.S.C. § 103(a)

The Examiner rejects claims 34-36, 42, 52-54, 60, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Wollrath et al. in view of Allard et al. As mentioned above in section III of this response, Applicants submit that Wollrath et al.

Applicants' application has an effective filing date of March 20, 1998, which is less than one year from the publication date of Wollrath et al., i.e., May/June 1997. Further, although Applicants disagree with the Examiner's contentions that Wollrath et al. "discloses the elements of claim 28," See *Office Action*, page 5, line 17, Applicants nevertheless provide declarations pursuant to 37 C.F.R. § 1.132 from the inventors to remove Wollrath et al. as an available reference under 35 U.S.C. § 102.

Because the declarations under 37 C.F.R. § 1.132 by Ann Wollrath and Jim Waldo eliminate Wollrath et al. as an available reference under 35 U.S.C. § 102, the rejection of claims 34-36, 42, 52-54, 60, and 61 under 35 U.S.C. § 103(a) is unsupported, should be withdrawn, and the claims allowed.

Additionally, Applicants disagree with the Examiner's contentions that Allard et al. teaches "returning smart proxy information to the client" during a step of returning a resource locator. Allard et al. describes a usage tracking system that uses client side proxies for preparing a usage tracking data objects and posting the objects to a usage tracking server. The server collects the tracking data objects to create a usage log associated with World Wide Web sessions. The reference does not suggest returning smart proxy information to a client from a lookup service for access to a network service.

Because Wollrath et al. is unavailable as a reference in light of the 37 C.F.R. § 1.132 declarations, and Allard et al. does not support the Examiner's contentions set forth in the Office Action, Applicants request that the rejection of claims 34-36, 42, 52-54, 60, and 61 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

VI. New Claims 62-88

New claims 62-88 cover additional aspects of the invention. New claims 62-88 are distinguishable from the cited art for the reasons discussed above in connection with the response to the rejection of claims 28-61. Accordingly, for at least the same reasons set forth above in connection with claims 28-61, Applicants request the timely allowance of new claims 62-88.

VII. Conclusion

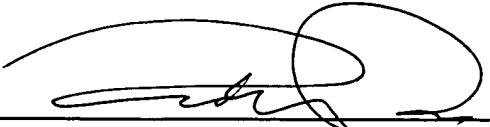
In view of the foregoing remarks, Applicants submit that claims 28-88 are neither anticipated nor rendered obvious in view of the cited art references cited against this application. Applicants therefore request reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 29, 2004

By: 
Joseph E. Palys
Reg. No. 46,508